

REMARKS

In the Office Action, the Amendment filed on May 15, 2003 was objected to under 35 U.S.C. § 132(a) as allegedly introducing new matter into the disclosure, claims 1, 3, 21-23, 49-51, 53-58 and 60 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly not complying with the written description requirement, and claims 52 and 53 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,343,536 to Groh.

Applicants thank the Examiner for the allowance of claims 4-20, 24-48, 59, 61 and 62. By this Amendment, rejected claims 1, 3, 21-23, 49-58, 60 and 63 are canceled without prejudice or disclaimer. Allowed claims 4-20, 24-48, 59, 61 and 62 are the only claims pending in this application. Accordingly, the application should be in condition for allowance.

Applicants respectfully traverse the objection to the Amendment filed May 15, 2003, under 35 U.S.C. § 132(a) and the related rejection of claims 1, 3, 21-23, 49-51, 53-58 and 60 under 35 U.S.C. § 112, first paragraph, because the originally-filed specification supports each of the limitations in the claims. In particular, the original specification supports the recitation of the transfer image not being a fingerprint or fingerprints, and the recitation of the external portion not including a tooth or teeth.

The MPEP specifically allows for reciting features in a negative manner when those features are positively recited in the specification. "If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453

(Fed. Cir. 1984).” M.P.E.P. 2173.05(i). Teeth are positively recited, for example, at page 4, line 13 of the specification. Similarly, teeth and nondermatoglyphic features, which include the *lack* of a fingerprint and/or fingerprints, are recited at page 8, lines 1-10 of the specification. Accordingly, the specification provides support for the recitations relating to a tooth/teeth and fingerprint(s):

To expedite prosecution and place the application in allowable form, Applicants have canceled claims 1, 3, 21-23, 49-51, 53-58, and 60, thus obviating the objection under 35 U.S.C. § 132(a), and the rejection under 35 U.S.C. § 112, first paragraph as they apply to those claims. Regarding allowed claims 4-20, 24-48, 59-61, and 62, those claims have tooth/teeth and fingerprint(s) recitations in common with those of the canceled claims, but, as explained above, the specification fully supports such recitations. Consequently, the objection under Section 132(a) and rejection under Section 112, first paragraph are no longer applicable.

With respect to the rejection under Section 102(b), Applicants respectfully submit that cancellation of claims 52 and 53 obviates the 35 U.S.C. § 102(b) rejection of those claims over Groh.

For at least the reasons mentioned above, the application should be in condition for allowance.

The Office Action contains a number of statements including assertions regarding the specification, claims, and/or a cited reference. Applicants decline to subscribe to any statement in the Office Action, regardless of whether it might be mentioned specifically herein.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

F. Chad Copier

Reg. No. 54,047